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CONFIDENTIAL

TO: Commissioner for Patents
FAX NO.: 571-273-8300
FROM: Peter Tong
RE: US Patent Application 10/734,932 Restriction Requirement Response
DATE: August 9, 2006
TOTAL PAGES (Including cover page): 10

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MESSAGE (if any):

Attached the Patent Office would find a Transmittal Letter (2 pages), and a Response to Restriction Requirement (7 pages).

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AUG 10 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application)	<u>PATENT APPLICATION</u>
Inventor(s):)	
SC/Serial No.:)	
Art Unit:)	3715
Attorney Docket #:)	
Filed:)	
Examiner:)	Harris, Chanda L
Title:)	
Computer-Aided Learning System and Method)	

CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being sent by facsimile (the fax number being 571-273-8300) to Mail Stop Amendment, Commissioner for Patents, P.O.Box 1450, Alexandria, VA 22313-1450 on August 9, 2006.

Colina Tong

(Signature)

RESPONSE TRANSMITTAL LETTER

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

Transmitted with this communication in connection with the above-identified application are the following:

- ☐ A Preliminary Amendment.
- ☒ A Response to Restriction Requirement.
- ☐ A Response under 37 C.F.R. § 1.116 to the Office Action dated _____.
- ☐ A Petition for an Extension of Time under 37 C.F.R. § 1.136.
- ☐ A Terminal Disclaimer.
- ☐ A Statement pursuant to 37 C.F.R. § 1.27 to establish small entity status under 37 C.F.R. § 1.9(f).
- ☐ An Information Disclosure Statement pursuant to 37 C.F.R. § 1.56.

The fee associated with this communication has been calculated as shown below:

- ☒ No fee is required with this communication.
- ☐ Small entity status of this application under 37 C.F.R. § 1.9 and § 1.27 has been established.
- ☐ A fee for extension of time for response under 37 C.F.R. § 1.136 filed within _____ month(s) after the original time for response of \$_____ is due.
- ☐ A fee of \$240.00 is due for the submission of the accompanying Information Disclosure Statement.

The total fee required with this communication is \$ 0.00 and is to be paid as follows:

- ☐ Please charge Deposit Account No. _____ in the amount of \$_____. A duplicate copy of this authorization is enclosed.
- ☐ A check in the amount of \$0.00 is enclosed.
- ☒ The Commissioner is hereby authorized to charge underpayment of any fees, including the following fees, associated with this communication or credit any overpayment to Deposit Account No. 50-0727.
- ☐ Any filing fee under 37 C.F.R. § 1.16 for the presentation of additional claims.
- ☐ Any patent application processing fees under 37 C.F.R. § 1.17 including any applicable fee for extension time.

Respectfully submitted,

Date: August 9, 2006

By: 

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)	
Attorney Docket #:)	
)	
Filed:)	Examiner: Harris, Chanda L
)	
Title:)	
)	
)	

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Communication dated July 26, 2006 (hereinafter, the "Office Communication"), regarding restriction requirements, Applicants hereby provisionally elect, with traverse, Group I, claims 13-16 and 23-26, to prosecute in the above-identified patent application. Nevertheless, the restriction requirements are respectfully traversed based on the reasons below.

On January 20, 2006, Applicants received a prior office action (hereinafter, the "Prior Office Action") regarding the above-identified patent application. The Prior Office Action rejected claims 13-32. Applicants filed a Response to the Prior Office Action, without adding any additional claims. Thus, claims 13-32 remained pending.

Following Applicants' Response to the Prior Office Action, Applicants received the Office Communication, which restricted claims 13-32 into four groups (hereinafter, the "Restriction Requirements"), as shown below:

- I. Claims 13-16 and 23-26, drawn to a computer-implemented method, classified in class 434, subclass 323.
- II. Claims 17-18 and 27-28, drawn to a computer-implemented method, classified in class 434, subclass 353.
- III. Claims 19-20, drawn to a computer-implemented method, classified in class 434, subclass 363.
- IV. Claims 21-22, drawn to a computer-implemented method, classified in class 434, subclass 236.

Applicants acknowledge the apology in the Office Action regarding the delay in the issuance of the Restriction Requirements. However, Applicants respectfully assert that the Restriction Requirements are not necessary, are not proper, and are prejudicial to Applicants. Based on the following remarks, Applicants respectfully request that the four-way Restriction Requirements be withdrawn, and that all the claims be examined. If the Examiner is unwilling to examine all the claims, at least the four-way restriction should be reduced to a two-way restriction. For example, at the very least Groups I and II should be combined into a single group, and Groups III and IV should be combined into another single group.

A. Restriction Inappropriate because Applicants are Unfairly Prejudiced

The four-way restriction requirement unnecessarily and substantially prejudices and burdens Applicants. Applicants filed this application in 2003, almost 3 years ago. A first Office Action was issued by the USPTO in January 2006, which is over 6 months ago. No restriction was included with the first Office Action.

If the Restriction Requirements are to be maintained, Applicants will need to file three divisional applications. Each divisional application may take another 2 or 3 years before a first Office Action issues. With the patent period being fixed at 20 years from the priority date, and with technologies moving at a very fast pace, the Restriction Requirements place substantial burdens on Applicants for many reasons. First, the Restriction Requirements unduly extend the prosecution period by subdividing the claims into 4 groups at this juncture of the prosecution. Further, the Restriction Requirements will significantly reduce Applicants patent term for those claims which may be filed in

divisional applications. Additionally, Applicants may lose significant amounts of licensing fees and/or damages, should infringement of non-elected claims occur prior to issuance of divisional applications that may be filed in response to the Restriction Requirements.

Moreover, three of the Groups of the Restriction Requirements only include 2 or 4 claims in total. If Applicants are required to file three divisional applications, Applicants may need to pay three more filing fees, three more issue fees, and maintenance fees for 3 more patents. This seems particularly unfair where three of the Groups only include 2 or 4 claims.

B. Restriction Improper Because no Serious Burden on Examiner

Under MPEP § 803, "If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions." A restriction requirement is proper only if there would be a serious burden on the examiner if restriction is not required. MPEP § 803 further explains that, "For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant."

The Office Communication categorized the pending claims into four groups in different classifications to try to satisfy the *prima facie* requirement of restriction. Such *prima facie* showing is hereby rebutted.

Restriction Improper based on Classifications

For purposes of the initial requirement, a serious burden on the Examiner may be *prima facie* shown by appropriate explanation of separate classification. It is unclear why certain classifications should be searched for one group, but not another group. Based on the following discussion, Applicants respectfully request withdrawal of the Restriction Requirements, unless the rationale behind the different classifications can be clarified.

Group I: Claims 13-16 and 23-26

The Office Action classified Group I under class 434, subclass 323. Regarding this classification,

Class 434 is "Education and Demonstration"

Subclass 322, is "Question or problem eliciting response", where a question or problem concerning an academic subject is presented to an examinee to obtain his or her response.

Subclass 323 (indented under subclass 322), is "Cathode ray screen display included in examining means".

It is unclear why subclass 323 is only applicable for the Group I set of claims, or why this classification is applicable at all.

More specifically, it is unclear why claims 13-16 and 23-26 (Group I) should be classified under subclass 323, as none of these claims include the language of a cathode ray screen display. Further, if the Examiner believes that a proper search for claims 13-16 and 23-36 requires a search of subclass 323, it is unclear why this subclass should not also be searched for the claims of Groups II, III and IV.

Subclass 323 is indented under subclass 322, which relates to questions or problems eliciting response. If claims 13-16 and 23-26 (Group I) are classified under subclass 322 because these claims relate to test results, then all the pending claims should be classified under subclass 322, because each of the pending claims relates to test results.

Group II: Claims 17-18 and 27-28

The Office Action classified Group II under class 434, subclass 353. Regarding this classification,

Class 434 is "Education and Demonstration"

Subclass 322, is "Question or problem eliciting response", where a question or problem concerning an academic subject is presented to an examinee to obtain his or her response.

Subclass 353 (indented under subclass 322) is "Grading or response form", where examinee's response is graded.

It is unclear why subclass 353 is only applicable to the Group II set of claims. If the rationale was based on the Group II set of claims including the limitations of analyzing test results, then it is unclear why this subclass should not also be searched for the claims of Groups I, III and IV, since they are also related to analyzing test results.

Group III: Claims 19 and 20

The Office Action classified Group III (claims 19 and 20) under class 434, subclass 363. Regarding this classification,

Class 434 is "Education and Demonstration"

Subclass 322, is "Question or problem eliciting response", where a question or problem concerning an academic subject is presented to an examinee to obtain his or her response.

Subclass 363 (indented under subclass 322), is "Card or sheet for receiving examinee's written, marked, or punched response" where a card [sic] or sheet has areas thereon for receiving an examinee's response as indicated by writing, a mark, or a punched hole.

It is unclear why this classification is only applicable for the Group III set of claims, or why this classification is applicable at all.

More specifically, it is unclear why claims 19 and 20 (Group III) should be classified under subclass 363, as none of these claims require that a card or sheet be used for receiving an examinee's response. Further, if the Examiner believes that a proper search for claims 19 and 20 requires a search of subclass 363, it is unclear why this subclass should not also be searched for the claims of groups I, II and IV.

Group IV: Claims 21 and 22

The Office Action classified Group IV (claims 21-22) under class 434, and subclass 236. Regarding this classification,

Class 434 is "Education and Demonstration"

Subclass 236 is psychology, where subject matter relates to the behavioral characteristics of an individual or group.

It is unclear why this classification is only applicable for the Group IV set of claims. If the rationale was based on the Group IV set of claims being related to a user learning a subject, then subclass 236 should also be searched for the claims of Groups I, II and III, because they are also related to a user learning a subject.

Since the separate classifications are inappropriate and seem to lack sound rational bases, the threshold requirement of a serious burden on the Examiner without the Restriction Requirements has not been established. Without satisfying the *prima facie* requirement of restriction, the Restriction Requirements must be withdrawn.

Restriction Improper Because Substantial Overlap Among Groups

It is not proper to restrict claims into different groups when the inventions of the different groups substantially overlap in scope. For example, each Group includes limitations relating to "retrieving test results", "analyzing the test results", a "relationship rule", and "suggest certain activity for the user". Applicants submit that such common limitations indicate a fair amount of overlaps among all of the Groups I, II, III and IV.

Further, Groups I and II both include limitations related to selecting an area of a subject for a user to work on or to learn.

Also, both Groups III and IV include limitations related to determining a reward for a user. Overlaps between claims under Group III (claims 19 and 20) and Group IV (claims 21-22) are further illustrated in the table below.

19	A computer-implemented method for helping a user learn a subject, the subject having a plurality of areas, the method comprising:	21	A computer-implemented method for helping a user learn a subject, the subject having a plurality of areas, the method comprising:
19	retrieving test results from testing the user on at least one area of the subject after materials on the subject have been presented for the user to learn;	21	retrieving test results from testing the user on at least one area of the subject
19	analyzing the test results using a relationship rule to suggest certain activity for the user, wherein the relationship rule defines at least a relationship between at least two areas of the subject	21	analyzing the test results using a relationship rule to suggest certain activity for the user, wherein the relationship rule defines at least a relationship between at least two areas of the subject

19	determining a reward for the user based on one or more conditions relating to the user learning the subject, wherein the reward depends on a previously-known preference of the user	22	determining a reward for the user
20	determining whether to restrict the user from enjoying certain materials not for learning the subject, wherein the materials require a device to fulfill its entertainment purpose	21	determining, based on one or more conditions relating to the user learning the subject, whether to restrict the user from enjoying certain materials not for learning the subject wherein the restricting is achieved by modifying at least one function of a device with respect to the certain materials, and the materials require the at least one function of the device to fulfill the materials' entertainment purpose

Conclusion

Based on the above remarks, Applicants respectfully assert that the four-way restriction requirement is unnecessary, improper, and seriously prejudicial to and burdensome on Applicants. Thus, Applicants respectfully request that the four-way restriction requirement be withdrawn, and that all the claims be examined.

If there are any issues remaining which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned representative at the telephone number listed below.

Any required fee in connection with the filing of this response is to be charged to Deposit Account No. 50-0727.

Respectfully submitted,

By: 

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